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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,934	08/05/2003	Alberto Rodriguez	D/A2493	6540

25453 7590 11/02/2006

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EXAMINER

PHAM, CHRYSTINE

ART UNIT	PAPER NUMBER
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2192

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,934

Applicant(s)

RODRIGUEZ ET AL.

Examiner

Chrystine Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/03/2006; 08/05/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to application 10/634934 filed on August 5, 2003. Claims 1-27 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Donohue (US 6199204 B1).

Claim 1

Donohue teaches a method of programming one or more electronic devices (see at least 10 FIG.3 & associated text) with device information (see at least 20 FIG.3 & associated text; *updater component, locations, network, required software resources* col.3:50-col.4:15), the method comprising: installing device programming software onto a programming system (see at least 230, 250 FIG.4A & associated text; 290-310 FIG.4B & associated text), wherein the installing comprises: verifying installation permissions (see at least 240, 260 FIG.4A & associated text; 360 FIG.4B & associated text); and installing programming software onto the programming system only if the installation permissions are verified (see at

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least 240, 260 FIG.4A & associated text; 360 FIG.4B & associated text); refilling the programming system with programming permissions (see at least FIG.3 & associated text; *updater component, preset criteria, update criteria, authenticity, cryptographic algorithms* col.5:1-50), wherein the refilling comprises: verifying refill permissions; and establishing predetermined programming permissions in the programming system only if the refill permissions are verified (see at least 240, 260 FIG.4A & associated text; 360 FIG.4B & associated text; *updater component, preset criteria, update criteria, authenticity, cryptographic algorithms* col.5:1-50; *updater component, installation scripts, INSTALLPATH* col.17:20-65); and programming electronic devices, wherein the programming comprises: determining if programming an electronic device is within the programming permissions of the programming system; detecting the presence of an electronic device to be programmed; and if programming an electronic device is within the programming permissions and an electronic device is present, using the programming software to program device information onto the electronic device (see at least *updater component, upgrading, software products, update criteria* col.3:65-col.4:53; *updater component, preset criteria, update criteria, authenticity, cryptographic algorithms* col.5:1-50; *updater component, installation scripts, INSTALLPATH* col.17:20-65).

Claim 8

The rejection of base claim 1 is incorporated. Donohue further teaches upon programming the electronic device, updating the programming permissions in the

programming system (see at least *updater component, preset criteria, update criteria, authenticity, cryptographic algorithms* col.5:1-50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-7, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue in view of Dayan et al. (US 6892305 B1, "Dayan").

Claim 2

The rejection of base claim 1 is incorporated. Donohue further teaches wherein verifying installation permissions comprises: reading and electronically verifying installation security code (see at least *updater component, secure holding area* col.17:20-65). Donohue does not expressly disclose reading installation card information from an installation security card and electronically verifying that the installation card information contains a predetermined installation security code. However, Dayan teaches a system and method for installing security features (see at least *security features, upgraded, security card* col.1:34-60; *public key, security feature element, installation, security card* col.2:47-67) comprising reading security information

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from a security card and electronically verifying that the security information contains predetermined security code (see at least 50-54 FIG.2 & associated text; *security card, encryption keys* col.1:34-60). Donohue and Dayan are analogous art because they are directed to installing software. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Dayan into that of Donohue for the inclusion of a verifying security code contained in security card. And the motivation for doing so would have been to facilitate secure system boot-up and protect sensitive data within the computer system from being comprised (see at least Dayan Abstract; col.1:10-col.2:16).

Claim 3

The rejection of base claim 1 is incorporated. Donohue (as modified by Dayan) further teaches wherein verifying refill permissions comprises: reading refill card information from a refill security card; electronically verifying that the refill card information contains a predetermined refill security code; entering a refill password into the programming system; and verifying in the programming system the refill password (see at least 240, 260 FIG.4A & associated text; 360 FIG.4B & associated text; *updater component, preset criteria, update criteria, authenticity, cryptographic algorithms* col.5:1-50; *updater component, installation scripts, INSTALLPATH* col.17:20-65; *updater installation userid, password* col.11:20-50).

Claim 4

The rejection of base claim 1 is incorporated. Claim recites limitations, which have been addressed in claim 3, therefore, is rejected for the same reasons as cited in claim 3.

Claim 5

The rejection of base claim 4 is incorporated. Donohue further teaches wherein establishing predetermined programming permissions comprises supplying to the programming system refill information and determining from the refill information programming permissions (see at least *updater component, upgrading, software products, update criteria* col.3:65-col.4:53; *updater component, preset criteria, update criteria, authenticity, cryptographic algorithms* col.5:1-50; *updater component, installation scripts, INSTALLPATH* col.17:20-65).

Claim 6

The rejection of base claim 1 is incorporated. Dayan further teaches wherein establishing programming permissions in the programming system comprises encrypting the programming permissions (see at least *encryption keys* col.1:35-60).

Claim 7

The rejection of base claim 6 is incorporated. Claim recites limitations, which have been addressed in claim 3, therefore, is rejected for the same reasons as cited in claim 3.

Claim 11

The rejection of base claim 8 is incorporated. Dayan further teaches wherein:
establishing predetermined programming permissions in the programming system
comprises establishing a control portion of the programming permissions in two storage
locations in the programming system; updating the programming permissions comprises
updating the control portion of the programming permissions in both of the two storage
locations; and determining if programming an electronic device is within the
programming permissions comprises examining from the two storage locations the
control portion of the programming permissions (see at least *security feature element*,
public key, private key, portion of public key, nonvolatile memory, computer system,
subsequent boot-up col.1:60-col.2:16; col.3:1-10; col.4:60-col.5:10).

Claim 12

The rejection of base claim 11 is incorporated. Claim recites limitations, which have
been addressed in claims 6 and 11, therefore, is rejected for the same reasons as cited
in claims 6 and 11.

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue
in view of Larsson et al. (US 6226747 B1, "Larsson").

Claim 9

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The rejection of base claim 8 is incorporated. Donohue does not expressly disclose the programming permissions includes an authorized programming count; and determining if the programming is within the programming permissions includes determining if the programming system has already programmed a number of devices at least equal to the authorized programming count. However, Larsson teaches a method for installing software program (see at least Abstract) wherein: the programming permissions includes an authorized programming count; and determining if the programming is within the programming permissions includes determining if the programming system has already programmed a number of devices at least equal to the authorized (i.e., maximum) programming count (i.e., maximum number of devices) (see at least 210, 242, 245, 250, 255 FIG.2a & associated text). Donohue and Larsson are analogous art because they are directed to software installation. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Larsson into that of Donohue for the inclusion of a programming (i.e., installation) count. And the motivation for doing so would have been to prevent software piracy in which authorized users of the software seek to exceed the limits (i.e., maximum number of computers) of their installation authorization (see at least Larsson *limited use licenses* col.1:15-45).

Claim 10

The rejection of base claim 9 is incorporated. Larsson further teaches wherein updating the programming permissions comprises decrementing the authorized programming

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count (see at least 245, 250 FIG.2a & associated text).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue in view of Ransom (US 7127328 B2).

Claim 13

The rejection of base claim 1 is incorporated. Donohue does not expressly disclose wherein storing permissions comprises storing at least a portion of the permissions in a computer registry file. However, Ransom teaches a system and method for securing electronic devices (see at least *Energy Management, EM components, EM software* col.3:13-col.5:8; *encryption, EM systems* col.6:52-col.7:12; FIG.2 & associated text) wherein storing permissions comprises storing (i.e., updating) at least a portion of the permissions in a computer registry file (see at least *name registry, EM devices, certificate, PKI techniques, CSV files, RDF files* col.12:57-col.13:42). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Ransom into that of Donohue for the inclusion of registry file. And the motivation for doing so would have been to maintain a record of updates associated with multiple removable/replaceable electronic devices and enable notifications to be communicated to the network to entities needing to know about the updates (see at least Ransom col.13:1-43).

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Claims 14, 18-20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue in view of Larsson further in view of Applicant's Admission of Prior Art (Specification, paragraph [0002], "AAPA").

Claim 14

Donohue teaches a method of programming one or more electronic devices with device information, the method comprising: establishing programming permissions in a programming system, wherein establishing programming permissions comprises: verifying refill permissions; and establishing programming permissions in the programming system only if the refill permissions are verified; examining the programming permissions to determine if programming an electronic device is within the programming permissions; if programming an electronic device is within the programming permissions, programming an electronic device with device information relating to a printing apparatus; updating the programming permissions to reflect that the electronic device has been programmed (see above claim 1); Larsson teaches determining if the updated programming permissions are below a predetermined threshold (see above claim 9); and if the updated programming permissions are below the predetermined threshold, requesting a refill of the programming permissions (see claims 1 and 9).

Donohue and Larsson do not expressly disclose said electronic devices as electronic *printer security* devices. However, AAPA teaches programming electronic printer security devices (see *electronic tracking devices, replaceable modules, printing*

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apparatus paragraph [0002]). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of AAPA into that of Donohue and Larsson for the inclusion of electronic printer security devices. And the motivation for doing so would have been to avoid the insertion of improper replaceable module that might damage the printer or produce unacceptable output (see at least AAPA paragraph [0002]).

Claims 18-19

Claims recite limitations, which have been addressed in claims 9-10, therefore, are rejected for the same reasons as cited in claims 9-10.

Claims 20, 25

Claims recite limitations, which have been addressed in claims 2, 6, 9-10 and 14, therefore, are rejected for the same reasons as cited in claims 2, 6, 9-10 and 14.

Claims 15-17 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue in view of Larsson, in view of AAPA further in view of Dayan.

Claims 15-17, 26-27

Claim 15 recites limitations addressed in claim 2. Claims 16 and 27 recite limitations addressed in claim 6. Claims 17 and 26 recite limitations addressed in claim 11. See

claims 2, 6 and 11.

Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue in view of Larsson further in view Dayan.

Claims 21-22, and 24

Claims recite limitations, which have been addressed in claims 1, 6 and 9-11, therefore, are rejected for the same reasons as cited in claims 1, 6 and 9-11.

Claim 23

The rejection of base claim 21 is incorporated. Dayan further teaches wherein issuing an error message if the control portions in the first and second storage locations differ from one another (see at least FIG.5 & associated text; *test result, fail, user notified* col.4:60-col.5:10).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chrystine Pham whose telephone number is 571-272-3702. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on 571-272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CP
October 23, 2006



TUAN DAM
SUPERVISORY PATENT EXAMINER